

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIPPE BUGNON and FRITZ HERREN

Appeal No. 1997-0687
Application No. 08/359,710

ON BRIEF

Before PAK, WALTZ, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 12, 19, 22, 24, 26, and 27 which are all the claims remaining in the application.

THE INVENTION

The invention is directed to a process for warp free pigmentation of polyolefins by adding to the polyolefins diketo-pyrrolopyrrole pigment particles coated with from 1 to 5% by weight of a polyvinyl pyrrolidone polymer. In a separate embodiment the coated pigment may be prepared by coating the diketo-pyrrolopyrrole pigment particles with 1 to 10% by weight of a vinyl pyrrolidone-vinyl acetate copolymer. In each embodiment the coated pigment particles are thereafter admixed with a polyolefin.

THE CLAIMS

Claims 24 and 27 are illustrative of appellants' invention and are reproduced below.

24. A process for warp-free pigmentation of polyolefins, which comprises:

(a) coating organic pigment particles, which are diketopyrrolopyrroles, with one or more films of a preformed polymer by adsorption of from 1 to 5% by weight of the polymer, based on the pigment, onto the surface of the pigment particles at room temperature, the polymer being selected from the group consisting of polyvinylpyrrolidone homopolymers and copolymers; and

(b) admixing the coated pigment particles with a polyolefin.

27. A process for the warp-free pigmentation of polyolefins, which comprises:

(a) coating organic pigment particles, which are diketopyrrolopyrroles, with one or more films of a preformed polymer by adsorption of 1 to 10% by weight of the polymer, based on the pigment, onto the surface of the pigment particles at room temperature, the polymer being a polyvinylpyrrolidone-vinyl acetate copolymer; and

(b) admixing the coated pigment particles with a polyolefin.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references.

Hopfenberg et al.	3,904,562	Sep. 9, 1975
(Hopfenberg)		
Loch	4,388,435	Jun. 14, 1983
Martin	4,771,086	Sep. 13, 1988
Bugnon et al.	4,808,230	Feb. 28, 1989
(Bugnon)		
Kamada et al.	4,957,949	Sep. 18, 1990
(Kamada)		

THE REJECTIONS

Claims 12, 19, 22, 24 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hopfenberg in view of Kamada.

Claims 12, 19, 22, 24 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hopfenberg as modified by Kamada as applied to claims 12, 19, 22, 24 and 26 above and further in view of Bugnon.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over Martin as modified by Hopfenberg in view of Bugnon and further in view of Loch.¹

¹ This rejection of claim 27 appears for the first time in the Answer. See page 5. No such rejection appears in either the Office action dated April 12, 1995, paragraph 20, or in the Final Office action dated August 29, 1995. However, appellant has responded to the Answer by submission of a Reply B no objection was raised to the examiner's statement of the rejection. Moreover, we are able to dispose of the rejection based upon one of the indispensable secondary references required in all but one of the rejections before us for consideration. Accordingly, we retain the rejection for consideration on its merits.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over each of Hopfenberg in view of Kamada or Hopfenberg as modified by Kamada in view of Bugnon, each as applied to claims 12, 19, 22, 24 and 26 and further in view of Loch.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with the appellant that the aforementioned rejections under 35 U.S.C. § 103 are not well founded. Accordingly, we will not sustain any of the rejections.

The Rejections under Section 103 -- Obviousness

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability,” whether on the grounds of anticipation or obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In the case before us, the examiner relies upon five references in multiple combinations, in five separate rejections to reject the claimed subject matter and establish a prima facie case of obviousness.

All but one of the rejections rely on a reference to Bugnon, which is the sole reference directed to the claimed diketopyrrolopyrroles. As to the rejection of Hopfenberg in view of Kamada, the examiner has stated that neither Hopfenberg nor Kamada discloses the various diketo-pyrrolopyrrole pigments. See Answer, page 4. That omission in and of itself constitutes reversible error. The mere possibility that the processes of Hopfenberg could be modified such that the diketo-pyrrolopyrrole pigments recited in the claimed subject matter were substituted for the pigments of Hopfenberg does not make the claimed processes obvious, absent a suggestion in the prior art of the desirability of such a modification. The absence of that suggestion or motivation in and of itself is sufficient to conclude that no prima facie case of obviousness had been established. See *In re Ochai*, 71 F.3d 1565, 1569-1570, 37 USPQ2d 1127, 1131-1132 (Fed. Cir. 1995).

The basic premise of each of the balance of the rejections is that Bugnon discloses numerous organic pigments including diketo-pyrrolopyrrole pigments as functionally equivalent pigments. It is the examiner's position that it would have been obvious to one of ordinary skill in the art to substitute the diketo-pyrrolopyrrole pigments of Bugnon for the pigments taught by Hopfenberg, Answer, pages 4 and 5, and Martin, as Martin does not disclose the claimed specific diketo-pyrrolopyrrole pigments. See Answer, page 6. We disagree.

Bugnon discloses coating organic pigments with fixed metal oxides additionally having a dense highly crosslinked coating of silica and/or alumina fixed by polycondensation of a silicate and/or aluminate with the free hydroxy groups of ethyl cellulose. See Bugnon, column 1, lines 43-50. Although the examiner suggests substituting the pigments for each other, the pigments of Bugnon do not exist as separate entities as discussed *supra*, but as coated fixed oxide entities. Moreover, no explanation is offered by the examiner as to why the person having ordinary skill in the art would have taken the fixed oxide layer taught by Bugnon, removed the highly crosslinked coating of silica and/or alumina, removed the oxide layer and substituted the polyvinyl pyrrolidone layer of Hopfenberg. In the absence of such an explanation, no prima facie case of obviousness can be established.

Furthermore, the second declaration of Bugnon, directed to a comparison of two different amounts of diketo-pyrrolopyrrole pigments coated respectively with 4.996% and 28% polyvinyl pyrrolidone, provides additional evidence of the unexpected superiority of appellants' claimed subject matter over the closest prior art.

Based upon the above analysis, we have determined that the examiner's legal conclusion of obviousness is not supported by the facts. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

DECISION

The rejection of claims 12, 19, 22, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Hopfenberg in view of Kamada is reversed.

The rejection of claims 12, 19, 22, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Hopfenberg as modified by Kamada as applied to claims 12, 19, 22, 24 and 26 above and further in view of Bugnon is reversed.

The rejection of claim 27 under 35 U.S.C. § 103 as being unpatentable over Martin as modified by Hopfenberg in view of Bugnon and further in view of Loch is reversed.

The rejection of claim 27 under 35 U.S.C. § 103 as being unpatentable over each of Hopfenberg in view of Kamada or Hopfenberg as modified by Kamada in view of Bugnon, each as applied to claims 12, 19, 22, 24 and 26 and further in view of Loch is reversed

The decision of the examiner is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
PAUL LIEBERMAN)	
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Application No. 08/359,710

APJ LIEBERMAN

APJ WALTZ

APJ PAK

DECISION: REVERSED

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s):

Prepared: March 2, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT